REMARKS

Claims 1-19 are pending in the Application.

Claims 1, 5, 10, 14-19 are rejected under 35 U.S.C. § 102(b) as anticipated by Maher, III et. al., U.S. Patent No. 6,381,242 ("Maher.") Applicant respectfully traverses the rejections.

At page 3 of the Office Action, the Examiner applies Maher to the elements of claim 1. With all due respect, it is submitted that that application of Maher is misplaced. Specifically, Maher does not contain the third element of the claim ("indicating, via said proscribed code scanner to said transfer component, whether said code contains proscribed code, without transmitting said code to said transfer component.")

The Examiner is absolutely correct that his recited excerpt from Maher states: "The conclusion of the content scanning are then sent back to the payload scanning interface 344..." But before that excerpt, and after that excerpt, Maher discusses one of those conclusions, which is a conclusion that the scanned data contains code that matches the string comparison unit. See Col. 9, lines 26 – 42 and then Col. 9, line 57 to Col. 10, line 14.

In other words, Maher has three possible "conclusions" resulting from its scanning process. As Maher states:

The conclusion of the content scanning can be any of a number of possible conclusions.

[1] The scanning may not have reached a conclusion yet and may need additional data from a new data packet to continue scanning in which case the state of the traffic flow, which can be referred to as an intermediate state, and any incomplete

7

scans are stored in session memory 354 along with other appropriate information such as sequence numbers, counters etc.

[2] The conclusion reached by signature memory 366 may also be that scanning is complete and there is or isn't a match, in which case the data packet and the conclusion are sent to transmit engine 352 for passing to QoS processor 116 from FIG. 2.

[3] The scanning could also determine that the data packet needs to be forwarded to microprocessor 124 from FIG. 2 for further processing, so that the data packet is sent to host interface 350 and placed on host interface bus 372.

(Col. 9, line 57 to Col. 10, line 14.)

Maher's second alternative – which is really the only close alternative to the second element of the claim – is really not like the element of the claim.

Maher's second alternative is:

The conclusion reached by signature memory 366 may also be that scanning is complete and there is or isn't a match, *in which case the data packet and the conclusion are sent to* transmit engine 352 for passing to QoS processor 116 from FIG. 2. (Col. 10, lines 1 – 5, emphasis added.)

The element of the claim is:

- indicating, via said proscribed code scanner to said transfer component, whether said code contains proscribed code, *without transmitting said code to said transfer component*

Maher does not meet the claimed element. It sends the data packet – which the Examiner is reading as "code" – and the conclusion to transmit engine 352. The element,

8

however, specifically disavows sending the code to the transfer component. Thus, Maher cannot be fairly held to be an anticipatory reference.

Accordingly, it is submitted that the limitations of independent claim 1 are not met by the Maher reference, and it is respectfully requested that the Examiner's rejection be withdrawn and the claims proceed to issue.

Claim 5 depends from claim 1, and so contains all the limitations of that base claim. Accordingly, it is respectfully requested that the Examiner's rejection be withdrawn and the claim proceeds to issue.

Independent claims 10, 14, and 17-19 share the limitation as noted above with regard to claim 1, and thus the remarks above with regard to claim 1 also apply here. Accordingly, it is respectfully requested that the Examiner's rejection be withdrawn and the claims proceed to issue.

Claims 15 and 16 depend from claim 1, and so contain all the limitations of that base claim. Accordingly, it is respectfully requested that the Examiner's rejection be withdrawn and the claims proceed to issue.

Claims 2, 3, 6, 7, 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher in view of Bandini, U.S. Published Patent Application No. 2002/0199095 ("Bandini.") Applicant respectfully traverses the rejections for a number of reasons.

First, as to independent claim 6, and as noted above with regard to claim 1, Maher dos not teach the limitation of "- indicating, via said proscribed code scanner to said at least one first transfer component, whether said code contains proscribed code, without transmitting said code to said transfer component."

9

Second, dependant claims 2, 3, 7, 11 and 12 all possess the limitations of the base claims from which they depend. As noted above, those base claims are allowable, and so these dependant claims are allowable.

Third, Bandini possess a filing date later than the instant case. Accordingly it cannot be considered prior art.

Fourth, obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Maher according to the teachings of Bandini. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Maher nor Bandini considered alone or in combination, describe or suggest the claimed combination.

Furthermore, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching.

The Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims, *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to

combine such references, and a reasonable expectation of success must be both found in

the prior art, and not based on Applicant's disclosure, In re Vaeck, 20 U.S.P.Q.2d 1436

(Fed. Cir. 1991.) In the present case, neither a suggestion or motivation to combine the

prior art disclosures, nor any reasonable expectation of success has been shown.

Accordingly, it is respectfully requested that the Examiner's rejection be

withdrawn and claims 2, 3, 6, 7, 11 and 12 proceed to issue.

Claims 4, 8 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable

over Maher in view of Bandini, and further in view of Card et. al., U.S. No. 6,941,478

("Card.") Applicant respectfully traverses the rejections for a number of reasons.

As was noted above, there are at least four reasons why a combination of Maher

and Bandini does not make the present invention obvious. Those reasons are as equally

applicable here – and if anything, since there is no teaching nor suggestion in the cited art

for the claimed combination, the Section 103 rejection appears to be based on a hindsight

reconstruction in which isolated disclosures have been picked and chosen in an attempt to

deprecate the present invention – a prohibited combination of teachings selected from

multiple patents in an attempt to arrive at the claimed invention.

Moreover, Card has a filing date later than the instant application, and so cannot
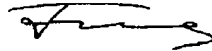
be competent prior art.

Accordingly, it is respectfully requested that the Examiner's rejection be

withdrawn and claims 4, 8 and 13 proceed to issue.

11

CONCLUSION

Claims 1-19 define patentable subject matter over the art of record and are not

anticipated by or obvious in view of the references of record.

Therefore, for the reasons given above, Applicant submits the application is now

in condition for allowance and Applicant respectfully requests early issuance of the

Notice of Allowance.

Respectfully submitted,

Joseph E. Chovanes
Registration No. 33,481
Suite 329
5 Great Valley Parkway
Malvern, PA 19355
Dated: January 31, 2006   (610) 648-3994

12